



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/823,404

04/13/2004

Christopher J. Nagel

2751.2001 US7

3242

38473 7590 08/05/2009  
ELMORE PATENT LAW GROUP, PC  
515 Groton Road  
Unit 1R  
Westford, MA 01886

EXAMINER

KOPEC, MARK T

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,404	<b>Applicant(s)</b> NAGEL, CHRISTOPHER J.	
	<b>Examiner</b> Mark Kopec	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 44-49 and 51-54 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44-49 is/are allowed.
- 6) ☒ Claim(s) 51-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/16/09</u> .  | 6) <input type="checkbox"/> Other: _____                          |

This action is responsive to applicant's amendment/remarks filed 04/14/09. Claims 44-49 and 51-54 are currently pending.

The IDS filed 07/16/09 has been considered. An initialed copy accompanies this action.

The previous 112, second paragraph, rejection (of claims 48, 51, 52 and 54) is **withdrawn** in view of applicant's amendment and remarks.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 51-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection is maintained for the reasons set forth in the Rejection mailed 02/04/09 (pages 4-5).

Applicant's remarks filed 04/14/09 have been fully considered.

With respect to the 112 written description requirement, the examiner does not dispute that applicant has demonstrated that the "tailored" copper compositions exhibit some type of

Art Unit: 1796

magnetic properties. As applicant has stated, such claims were allowed in parent 10/659,090 (U.S. 7,238,297) and indicated allowed in the instant application (instant claims 44-49). However, while the specification describes the magnetic properties of the copper composition, there is not description or discussion of the instant claim terminology relating to "Gauss readings..." (claims 51-52, 54) or "independent of pole" (claim 53). Furthermore, the 1.132 Declaration (copy filed 07/03/08) does not provided basis for such terminology. The 1.132 Declaration (magnetic properties appear on pages 11-12 of the Declaration) has no description or testing relating to the claim terminology. An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). While applicant contends that the claim terminology is inherent in the instant copper compositions, the examiner respectfully submits that there is no evidence of record conclusively demonstrating such.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 51-54 are rejected under 35 U.S.C. 102(b) as being anticipated by either Svensson et al (*Magnetic and electrical properties of copper-iron...*), Dovgopol et al (*Magnetic, thermodynamic, and kinetic properties of copper containing 0.4-2.0 atom% iron impurities*), or Campbell et al (*A Moessbauer study of the magnetic properties of copper-iron(CuFe) alloys*).

Svensson et al discloses Cu-Fe alloys containing 0.2-1.7 atom% Fe (Abstract).

Dovgopol et al discloses Cu-Fe alloys containing 0.4-2.0 atom% Fe (Abstract).

Campbell et al discloses Cu-Fe alloys containing 0.24-4.6 atom% Fe (Abstract).

The reference specifically or inherently meets each of the claimed limitations.

Applicant's remarks regarding this rejection are noted.

It is noted that applicant has deled the claim terminology "substantially" and "essentially" from the above instant claims.

Art Unit: 1796

However, the examiner respectfully submits that the above prior art, which discloses copper compositions possessing small amounts of magnetic iron, meets the claim limitations. Specifically, none of the instant claims possess language which precludes magnetic iron from copper compositions.

The examiner respectfully submits that the above prior art references specifically or inherently meets each of the claimed limitations.

In view of the foregoing, the above claims have failed to patentably distinguish over the applied art.

Claims 44-49 are allowable over the prior art. See Reasons for Allowance in previous Rejection (mailed 02/04/09).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1796

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Kopec whose telephone number is (571) 272-1319. The examiner can normally be reached on Monday - Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Kopec/  
Primary Examiner, Art Unit  
1796

MK  
August 3, 2009